

## REMARKS

Claims 1-16 are currently pending in the present application. By this Amendment, claims 17-20 have been added as set forth above. Claims 1-4, 6-12, and 14-16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 6,424,996 ("Killcommons") in view of United States Patent No. 5,649,185 ("Antognini"). Claims 5 and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Killcommons, Antognini and further in view of Computer Dictionary Third edition, Microsoft Press, 1997, ISBN 1-57231-446-X, p. 462. The Applicants respectfully traverse these rejections at least for the reasons discussed below, and already set forth during earlier prosecution of the present application.

### **I. The Combination Of Kilcommons And Antognini Does Not Render The Pending Claims Of The Present Application Unpatentable**

The Applicants first turn to the rejection of claims 1-4, 6-12, and 14-16 under 35 U.S.C. 103(a) as being unpatentable over Killcommons and Antognini. Kilcommons discloses a browser enhancement nodule and a server. See Kilcommons at Abstract. "The server includes a data interface for acquiring the multimedia data and a storage unit for receiving and storing the data. An assembly unit in the server gathers selected data to form an e-mail package in response to instructions from a remote user unit." *Id.*

Kilcommons, however, does not teach, nor suggest, a "second interface unit located at a second location and arranged to store second stored image data of the second patient on the second image storage unit in response to the second imaging data and to store second stored identification data on the server located at the first location in response to the second identification data," as recited, for example, in claim 1 of the present application. Instead, Kilcommons discloses a server that is adapted to store multimedia medical data (e.g., parameter

and/or clinical data)....” See *id.* at column 3, lines 59-62. See also *id.* at column 4, lines 19-22 (“multimedia medical data [is] stored by the server....”); column 4, lines 61-62 (“the server having stored therein medical files containing multimedia medical data”); column 5, lines 10-13.

Kilcommons does disclose that data may be sent from a user through the server.

The user unit 50 may have components to optionally view, manipulate, store and/or print data configured by modality 16 or modality 12. The user unit may transfer such data to the server 20 and/or send the information to another user 80 through the server 20.

*Id.* at column 7, lines 6-10. Kilcommons does not, however, teach or suggest that identification data is stored at the server while the imaging data is stored at a separate location (e.g., at a second imaging storage unit located remote from the location in which the server is located). There is nothing in Kilcommons to suggest that when data is transferred from a user unit to another user unit through the server, that identification data is stored at the server, while the imaging data is stored at remote locations. For example, Kilcommons states that the “server 20 in information transfer system 10 is a computer system that stores medical data and is accessible through a network, e.g., the internet, an intranet, or an extranet.” *Id.* at column 7, lines 53-55 (emphasis added).

Kilcommons does disclose that data may be stored at local hard drives.

After viewing the image, the data may be saved to a local hard drive by save control 134, printed by the print control 136 and/or sent to another location via the server 20 by email control.

*Id.* at column 14, lines 64-67. However, Kilcommons does not teach that only image data is stored at the local hard drive, while the identification data is stored at the server 20.

Overall, Kilcommons does not teach, nor suggest, interface units arranged to store stored image data at image storage units, and which store identification data on a server that is separate

and distinct from the image data storage units, as recited in claim 1. Similarly, Kilcommons does not teach, nor suggest, storing stored image data at image storage units in response to the imaging data and storing stored identification data at a separate location, such as a server, in response to the identification data, as recited in claim 9.

Having shown that Kilcommons does not teach, nor suggest, these limitations, the Applicants now move on to Antognini. The Applicants respectfully submit that the combination of Kilcommons and Antognini would result in multiple servers. "A prior art references must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP at 2141.02. Thus, Kilcommons and Antognini must be considered in their entireties. Antognini discloses a library server 12, which has a catalog store 19, and a plurality of image servers 14 and 15. See Antognini at column 4, lines 50-63. As such, combining Antognini with Kilcommons would result in multiple servers. Further, such a combination would include one server that does not store identification data at a separate location from image data (Kilcommons), another library server that stores a catalog store, and additional servers that store image data (Antognini). Moreover, the Applicants respectfully submit that attempting to pick and choose a single isolated element from Antognini and shoehorn it into Kilcommons ignores the references in their entireties and is therefore improper. There simply is no suggestion in either reference to combine the two references to arrive at the invention recited in the claims of the present application. Even if one assumed that the combination did teach the limitations recited in the claims, there simply is no motivation to combine these references.

"In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether

the claimed invention as a whole would have been obvious.” MPEP at 2141.02. The law is well settled that “obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so.” *ACS Hospital Systems, Inc. v. Montfiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929 (Fed. Cir. 1984). It is not permissible to pick and choose among the individual elements of assorted prior art references to re-create the claimed invention, but rather “some teaching or suggestion in the references to support their use in the particular claimed combination” is needed. *Symbol Technologies, Inc. v. Opticon, Inc.* 935 F.2d 1569, 1576, 19 USPQ2d 1241 (Fed. Cir. 1991).

In *Ex parte Hiyamazi*, the Board of Patent Appeals and Interferences reversed a rejection based on a combination of references, stating, in part:

Under 35 USC § 103, where the Examiner has relied upon the teachings of several references, the test is whether or not the reference viewed individually and collectively would have suggested the claimed invention to the person possessing ordinary skill in the art. Note *In re Kaslow*, 707 F.2d 1366, 107 USPQ 1089 (Fed.Cir. 1983). It is to be noted, however, that citing references which merely indicate the isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed references would have been obvious. That is to say, there should be something in the prior art or a convincing line of reasoning in the answer suggesting the desirability of combining the claimed invention. Note *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed.Cir. 1986).

*Ex parte Hiyamazi*, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Interf. 1988).

Antognini discloses multiples servers to store catalog information and image data. Combining Antognini with Kilcommons would result in multiple servers. Kilcommons does not teach, nor suggest, storing identification data on a server while image data is stored on separate image storage units. Further, Antognini simply does not teach, nor suggest, a single server in

which identification data is stored, while image data is stored on separate storage units. Instead, Antognini discloses the use of multiple servers to store information.

In combining Kilcommons and Antognini, the Office Action has merely picked and chosen among isolated, individual elements of separate references to re-create the Applicants' claimed invention. There is no teaching or suggestion in these references to support their use in the particular claimed combination. The proposed combination represents "the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed.Cir. 1983). Thus, at least for these reasons, the Applicants respectfully submit that the claims of the present application should be in condition for allowance.

## **II. Image Data Are Not Inherently Associated With Identification Data**

The current Office Action also states the following:

The teachings of Kilcommons and Antognini (Prior arts of record) are directed to 35 USC § 102/103 rejection wherein the secondary reference [i.e., Antognini] has been cited for disclosing that in a client/server data management system, **image data are inherently associated with an identification data** (i.e., storing identification data associated with the input data).

January 12, 2005 Office Action at page 3 (emphasis added). The Applicants respectfully submit, however, that image data is not inherently associated with identification data, as recited in claim 1, particularly where the identification data includes a patient's name, time of imaging, circumstances of the imaging, or identification number identifying the stored imaging data, as recited in the new claims of the present application. Further, image data is not inherently associated with identification data, particularly when the identification data is stored at a separate

location (e.g., a server) than the image data (e.g., an image storage unit at a second location).

“The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” See Manual of Patent Examining Procedure at § 2112, citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

See *id.*, citing *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added). The Applicants respectfully submit that neither the cited art of record, nor the Office Action “make[s] clear that the missing descriptive matter,” said to be inherent, “is necessarily present in” the cited art of record.

A rejection based on inherency must be based on factual or technical reasoning:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

See *id.*, citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis added).

The Applicants respectfully submit that the Office Action does not contain a basis in fact

and/or technical reasoning to support the statement that "image data are inherently associated with an identification data." Accordingly, the Applicants respectfully submit that, absent a "basis in fact and/or technical reasoning" for the rejection of record, the rejections should be reconsidered and withdrawn.

### III. Conclusion

In view of the foregoing, it is respectfully submitted that pending claims of the present application define allowable subject matter. The Applicants respectfully request reconsideration of the claim rejections. No fee is believed due with respect to new claims 17-20 because the present application does not include more than 20 total claims, nor does it include more than 3 independent claims.

Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the telephone number listed below. Please charge any additional fees or credit overpayment to Applicants' Deposit Account 07-0845.

Respectfully submitted,

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